REMARKS/ARGUMENTS

The claims have been amended as set forth above. Claims 3 and 16 are canceled. New claim 23 is added. No new matter has been added. Applicants respectfully request a notice of allowance of the claims.

I.   Statement Regarding the Four Declarations of this Application

A first Office Action was mailed for this application on June 7, 2005. The Office Action rejected claims 1-19 under 35 U.S.C. 102(a) as being anticipated by Microsoft Corporation, "Draft: Discovery of Web Services (DISCO)" (hereinafter "The DISCO Document"). Claims · 20-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over The DISCO Document in view of U.S. Publication No. 2003/0112270A1 published to Newell (hereinafter "Newell"). In response to the Office Action dated June 7, 2005, a first declaration was executed by each of the co-inventors. In pertinent part, the first declaration stated that "[t]he technical content that was provided to the author of the DISCO document was provided by the inventors." The first declaration also stated that "[i]n pertinent part, the content of the DISCO document corresponds to the inventors' own work."

A Final Office Action was mailed for this application on August 11, 2005. The Final Office Action maintained the rejection of claims 1-19 under 35 U.S.C. 102(a) as being anticipated by The DISCO Document. Also, claims 20-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over The DISCO Document in view of Newell. In response to the first declaration, the Final Office Action pointed applicants to MPEP 715.01(c), Section II - Derivation. The Final Office Action requested a "submission of evidence establishing the fact that the patentee, applicant of the published application, or author derived his or her knowledge of the relevant subject matter from applicant."

In response to the Final Office Action, a second declaration was submitted with an Amendment After Final. The second declaration included two copies. The first copy of the second declaration was signed by Erik Christensen and Andrew Layman on October 14, 2005. The second copy of the second declaration was signed by Henrik Nielsen on October 27, 2005. The first copy of the second declaration has an Appendix B, which includes a final version of the

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DISCO document. The first copy of the second declaration also has an Appendix C, which includes an email thread dated July 7, 2000. The email thread includes inventor comments for suggested revisions to the DISCO document. The email thread also includes as an attachment the final version of the DISCO document authored by the inventors. The email thread indicates that the final version of the DISCO document was sent from Erik Christensen (a co-inventor) to Sara Williams, a technical writer who prepares documents for publication on the Microsoft developer network. The first copy of the second declaration includes a statement that Ms. Williams only made formatting modifications to the inventor-authored DISCO document before publishing the DISCO document. With regard to the second copy of the second declaration, the second copy was mistakenly submitted in that it is a copy of the first declaration (please see discussion below).

On November 9, 2005, an advisory action was mailed that indicated that the second declaration would not be entered. On December 2, 2005, a Request for Continued Examination, including the second declaration, was filed.

On February 21, 2006, an Office Action was mailed in response to the Request for Continued Examination. The Office Action maintained the rejection of claims 1-19 under 35 U.S.C. 102(a) as being anticipated by The DISCO Document. Also, claims 20-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over The DISCO Document in view Newell. Claims 1, 10-14, 16-17, and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,631,496 issued to Li (hereinafter "Li"). Claims 2-9, 18 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view in view of U.S. Patent No. 6,651,059 issued to Sundaresan (hereinafter "Sundaresan"). Claims 15, 19, and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of U.S. Publication No. 2002/0103829 published to Manning (hereinafter "Manning).

The second declaration was also rejected in the February 21, 2006 Office Action. The Office Action noted that the first copy of the second declaration and the second copy of the second declaration are different. The Office Action stated that "there appears to be a contradiction regarding authorship of the DISCO document." The Office Action also stated that "the submission of the final version of the DISCO document does not provide the background

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necessary to show that the original DISCO document was authored by the inventors." The
Office Action continued by stating that "[t]he email thread provided in Appendix C implies that
co-inventor Erik Christensen was involved in revisions to the DISCO document, however it does
not show authorship."

On May 22, 2006, a response to the Office Action of February 21, 2006 was filed. The.
May 22, 2006 response included a third declaration. The third declaration included a first copy
and a second copy. The first copy of the third declaration was signed by Erik Christensen and
Andrew Layman on October 14, 2005. The first copy of the third declaration was the same as
the first copy of the second declaration. The second copy of the second declaration was signed
by Henrik Nielsen on March 16, 2006. The second copy of the third declaration included the
same language of the first copy of the third declaration. The second copy of the second
declaration was filed to remedy the filing mistake of the prior Office Action. The remarks of the
May 22, 2006 response state that "[t]he second declaration, signed by Hendrik Frystyk Nielsen,
incorrectly identifies at paragraph 5 that the technical content of the DISCO document was
provided to the author of the DISCO document by the inventors." The response included the
second copy of the third declaration that correctly identifies at paragraph 5 that the co-inventors
of the present application authored the final version of the DISCO document.

In reply to the May 22, 2006 response, the Final Office Action dated August 4, 2006 was
entered. The Office Action rejected claims 1-19 under 35 U.S.C. 102(a) as being anticipated by
The DISCO Document. Also, claims 20-22 were rejected under 35 U.S.C. 103(a) as being
unpatentable over The DISCO Document in view of Newell. Claims 1, 10-14, 16-17, and 20
were rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of U.S. Patent No.
6,571,248 issued to Kusama (hereinafter "Kusama"). Claims 2-9, 18 and 22 were rejected under
35 U.S.C. 103(a) as being unpatentable over Li in view of Kusama and further in view of
Sundaresan. Claims 15, 19, and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable
over Li in view of Kusama and further in view of Manning.

The third declaration and supporting evidence filed on May 22, 2006 was found
ineffective to overcome The DISCO Document. In light of several interviews with Examiner

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Ries and Primary Examiner Bashore, applicants submitted a fourth declaration with an amendment after final dated December 4, 2006

Appendix A included a final version of the DISCO document. The fourth declaration indicated that the subject matter of the final version of the DISCO document was derived from the inventors. Appendix B included an email thread dated July 7, 2000. The email thread included a link to an internally updated version of DISCO Document. Appendix C included a printout of the document associated with the link in the email thread. The fourth declaration indicated that the subject matter of the DISCO document associated with the link was derived from the inventors. Appendix D was a printout of the source code of the internally updated version of the DISCO document associated with the link. The fourth declaration indicated that page 1 of the source code identifies the author as "<erikc>." The fourth declaration also indicates that the alias "erikc" is the internal Microsoft alias for Erik Christensen.

Applicants asserted that the fourth declaration and supporting evidence overcame any assertions in the Office Action. The fourth declaration included a single declaration signed by the inventors. Also, the issue with Sara Williams was discussed in detail with both Examiner Ries and Primary Examiner Bashore. An agreement was reached that further evidence was not required for Sara Williams in that the fourth declaration and evidence remedied any issue with her name in the email chain.

In response to the amendment after final dated December 4, 2006, an advisory action was mailed on January 8, 2007. The advisory action entered the fourth declaration as being effective to remove The DISCO Document. However, the advisory action maintained that Claims 1, 10-14, 16-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Kusama. Claims 2-9, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Kusama and further in view of Sundaresan. Claims 15, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Kusama and further in view of Manning.

After review of the prosecution of this application, applicants' attorney proposes clarification of the record as follows:

1.   The inventors of this application were the authors of The DISCO Document.

2.   The first declaration did not specifically set forth the term "author". Therefrom, the authorship issue was confused, and the first Office Action requested a submission of evidence to prove "derivation." In hindsight, applicants' attorney believes that the submission of evidence to prove derivation was not necessary in that the inventors were authors.

3.   The second declaration mistakenly included two different copies of the second declaration, which further confused the issue of authorship. The third declaration included two of the same copies in attempt to remedy the issue.

4.   The fourth declaration was sufficient to remove The DISCO Document as a reference. Yet, applicants' attorney believes the declarations 2-4 were not necessary in that a clear assertion of authorship should have been sufficient at the onset to remove The DISCO Document.

II.   **Rejection of Claims 1, 10-14, 16-17, and 20 under 35 U.S.C. 103(a)**

Claims 1, 10-14, 16-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Kusama. Applicants respectfully disagree with the rejection. The independent claims have been amended as set forth above to clarify the features of the claims. Independent claim 1 includes the following combination of features not taught or suggested by the cited references:

issuing a request for the first resource identified by the first URI;

receiving a response document *from the first URI*;

parsing the response document received in response to the issued request, wherein the response document includes *a second URI for accessing a second resource, wherein the response document includes an indication that metadata about the first resource exists on the second resource*, wherein the indication indicates a metadata format;

generating a request to retrieve the metadata from the second resource, wherein the generated request is formatted to support the metadata format identified by the indication; and

retrieving the metadata from the second resource.

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Applicants assert that the references do not teach or suggest the above combination of features. Li teaches bookmarks and records maintained in association with the bookmarks. *Li*, at col. 5, lines 36-35. The records may include document specific metadata, user specific information and/or owner metadata. *Li*, at col. 5, lines 35-37. The information and metadata may be associated with the bookmark so that other users associated with the bookmark database can view the metadata or information. *Li*, at col. 5, lines 36-35. Figures 8A-8C depict an exemplary scenario of associating metadata with bookmarks.

Li also teaches querying a search engine. Li teaches that after the results of a search are obtained, a user can push a button to collect URLs of interest into Power Bookmarks. Li continues by teaching that "[w]hen a user request is issued, the system performs a sequence of tasks as follows: (1) downloading the documents pointed to by the collected URLs; (2) parsing metadata, such as links, keywords, and summary from the collected URLs; (3) indexing the collected URLs into formats usable by JTOPIC and WebDB 100; and (4) classifying the collected URLs into categories." *Li*, at col. 8, lines 16-22.

Li teaches that metadata is obtained when the document is obtained because Li is concerned with categorizing bookmarks and providing data about bookmarks. Contrariwise, independent claim 1 recites that a response document is received from a first URI. Independent claim 1 continues by teaching "parsing the response document received in response to the issued request, wherein the response document includes *a second URI* for accessing a second resource, wherein the response document includes *an indication that metadata about the first resource exists on the second resource*, wherein the indication indicates a metadata format." Again, Li does not teach the combination of a first URI, a second URI, a first resource, and a second resource as recited in claim 1. Li does not teach an indication that metadata about the first resource exists on the second resource. Moreover, there is no remedy in the other cited references for the lack of teaching in Li. Accordingly, applicants assert that claim 1 is allowable over the references.

Independent claim 11 includes the following combination of features not taught or suggested by the cited references:

issuing a request for a first resource *identified by a first URI* associated with the
request;

receiving a response document *from the first URI*;

parsing the response document received in response to the issued request, wherein
the response document *includes a second URI for retrieving a discovery
document, wherein the response document includes an indication that metadata
about the first resource is associated with the discovery document*;

using the second URI to generate a request to retrieve the discovery document
from the second resource; and

retrieving the discovery document *from the second resource*, wherein the
discovery document includes *a typed link that indicates that existence of further
metadata about the first resource*

Applicants assert that the references do not teach or suggest the above combination of
features. Li teaches that metadata is obtained when the document is obtained because Li is
concerned with categorizing bookmarks and providing data about bookmarks. Contrariwise,
independent claim 11 recites that a response document is received from a first URI. Independent
claim 11 continues by teaching "parsing the response document received in response to the
issued request, wherein the response document includes *a second URI* for retrieving a discovery
document, wherein the response document includes *an indication that metadata about the first
resource is associated with the discovery document*." Claim 11 continues by reciting "…a link
that indicates that existence of further metadata about the resource." Again, Li does not teach the
combination of a first URI, a second URI, a first resource, and a second resource as recited in
claim 1. Also, applicants can find no teaching of a typed link that indicates the existence of
further metadata about the first resource. Li does not teach an indication that metadata about the
first resource is associated with the discovery document. Moreover, there is no remedy in the
other cited references for the lack of teaching in Li. Accordingly, applicants assert that claim 11
is allowable over the references.

Independent claim 17 includes the following combination of features not taught or
suggested by the cited references:

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issuing a response document in response to a request for a resource at a first location *identified by a first URI*, wherein the response document *includes a second URI for accessing a second resource, wherein the response document includes an indication that metadata about the first resource exists on the second resource*, wherein the indication indicates a metadata format; and

issuing a request to retrieve the metadata *from the second resource*, wherein the request to retrieve the metadata is formatted to support the metadata format identified by the indication.

Applicants assert that the references do not teach or suggest the above combination of features. Li teaches that metadata is obtained when the document is obtained because Li is concerned with categorizing bookmarks and providing data about bookmarks. Contrariwise, independent claim 17 recites "issuing a response document in response to a request for a resource at a first location identified by a first URI, wherein the response document includes a *second URI* for accessing a second resource, wherein the response document includes *an indication that metadata about the first resource exists on the second resource*, wherein the indication indicates a metadata format." Again, Li does not teach the combination of a first URI, a second URI, a first resource, and a second resource as recited in claim 17. Li does not teach that the resource document includes an indication that metadata about the first resource exists on the second resource. Moreover, there is no remedy in the other cited references for the lack of teaching in Li. Accordingly, applicants assert that claim 17 is allowable over the references.

Independent claim 19 includes the following combination of features not taught or otherwise suggested by the cited references:

a processor; and

a memory having computer-executable instructions stored thereon, the computer-executable instructions being configured to:

issue a request for a first resource *identified by a first URI* associated with the request;

receive a response document *from the first URI*;

parse the response document received in response to the issued request, wherein the response document includes *a second URI for accessing a*

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> *second resource, wherein the response document includes an indication*
> *that metadata about the first resource exists on the second resource*;
>
> generate a request to retrieve the metadata *from the second resource*; and
>
> retrieve the metadata *from the second resource*.

Applicants assert that the references do not teach or suggest the above combination of features. Li teaches that metadata is obtained when the document is obtained because Li is concerned with categorizing bookmarks and providing data about bookmarks. Contrariwise, independent claim 19 recites that the computer-executable instructions are configured to "parse the response document received in response to the issued request, wherein the response document includes *a second URI* for accessing a second resource, wherein the response document includes *an indication that metadata about the first resource exists on the second resource*." Again, Li does not teach the combination of a first URI, a second URI, a first resource, and a second resource as recited in claim 19. Li does not teach that the response document includes an indication that metadata about the first resource exists on the second resource. Moreover, there is no remedy in the other cited references for the lack of teaching in Li. Accordingly, applicants assert that claim 19 is allowable over the references.

Regarding claims 10, 12-14, and 20, those claims include features not taught or otherwise suggested by the cited references. Moreover, those claims ultimately depend from independent claims 1, 11, 17 and 19, respectively. As such, they are thought allowable for at least the same reasons set forth above.

III.   Rejection of Claims 2-9, 15, 18-19 and 21-22 under 35 U.S.C. 103(a)

Claims 2-9, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Kusama and further in view of Sundaresan. Claims 15, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Kusama and further in view of Manning. Applicants respectfully disagree with the rejection. Applicants assert that the references are not combinable in the manner propounded. Furthermore, the rejection depends

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from the rejection above in Part II of this paper. As such, the claims are thought allowable for at least the same reasons set forth above.

IV.   Request For Reconsideration

In view of the foregoing remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number provided below.

Respectfully submitted,

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